

REMARKS

Applicants have carefully reviewed the arguments presented in the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Claims 1, 9, 11 and 14 were amended and claim 8 was canceled. Thus, claims 1-7 and 9-20 are pending in the application. No new matter was added by the aforementioned amendments.

Claims 1-20 were rejected under 35 U.S.C. 102(b) as being anticipated by Tomkow WIPO Publication WO 01/10090. Applicant respectfully traverses these rejections.

Claims 1 through 7 were rejected under 35 U.S.C. § 102(b), as being anticipated by Tomkow page 12, lines 21-24, which the Examiner states teaches "Additionally, the tag may contain instructions, World Wide Web addresses, or links that invite and allow the recipient to send a reply made or record to the message by linking to a Web Page from which messages made of record may be composed and sent." Applicant respectfully traverses the rejections in light of the arguments presented below.

The limitations of Claim 1 have been amended to recite "a return transmission of a reply from the recipient to the sender through the server, the reply not originating on the server." The Tomkow reference neither teaches nor suggests providing for a return transmission of a reply from the recipient to the sender through the server, the reply not originating on the server. This is not what is disclosed by Tomkow at page 10, lines 11-15, where Tomkow discloses storing destination information for the original message for the purposes of processing return receipt notifications. (Tomkow, page 10, lines 5-14, page 11, line 14, page 31, line 24, and page 32, line 6.) The Tomkow reference does not use this information for a return transmission of a reply from the recipient to the sender.

Moreover, the Tomkow reference, page 12, lines 21-24, teaches "links that invite and allow the recipient to send a reply made of record to the message by linking to a Web Page from which messages made of record may be composed and sent." Amended claim 1 does not claim linking to a Web Page from which messages made of record may be composed and sent. Rather, amended claim 1 recites "return transmission of a reply from the recipient to the sender through the server, the reply not originating on the server." (emphasis added). As discussed in the specification of pending application at page 55, paragraph 323, the reply is generated on a

recipients system, not on the server through which the original message was transmitted. Hence, the reply message of claim 1 originates from the recipient's default mail client, and does not originate on the server. Tomkow's reply originates from a Web Page from which messages made of record may be composed and sent, and therefore originates on a server displaced from the recipient. A Web Page from which messages made of record may be composed and sent is not the same as a recipient's default mail client.

Moreover, Tomkow also teaches a read receipt which is passed through the server by changing header information. (Tomkow, page 25, lines 25-33; page 15, lines 1-13). Claim 1 does not claim a read receipt which is passed through the server by changing the header information. Applicant's claim 1 provides for transmission of a reply, not a read receipt, to the sender through the server, the reply not originating on the server. A read receipt is an email sent to the author of a message by the recipient's Mail User Agent (MUA) when certain events occur (Tomkow, page 13, lines 20-21) and is consequently system generated. A reply is a new message initiated by the manual actions of a recipient and sent to the original sender by the recipient. Furthermore, a read receipt, unlike a registered reply, does not provide for proof of transmission or content of a reply generated by the recipient. A read receipt provides only proof of transmission or content of the original message. (Tomkow, page 25, lines 22-30.) Therefore, a read receipt cannot be a reply.

For the above stated reasons, Applicant respectfully submits that claim 1 is novel and not obvious in view of the cited reference. Applicant thus requests that the rejections be withdrawn and claim 1, and its dependent claims, be allowed.

Claims 8 and 11 were rejected under 35 U.S.C. § 102(b), as being anticipated by Tomkow. Applicant respectfully traverses the rejections.

Claim 8 has been cancelled and Claim 9 has been rewritten in independent form. Claim 9 was further amended to recite " storing the unique identification of the message and the sender including an address of the sender in a database by the server and determining by the server the identification and address of the sender through the identification of the message stored in the database." The amendment is supported by the original specification, pages 53-55.

The Tomkow reference does not teach or even suggest a method where the sender is provided with a unique identification related to the unique identification of the message. This is

not what is disclosed by Tomkow at page 16, lines 1-15, page 20, line 10, and page 21, line 6. Tomkow at page 16, lines 1-15, page 20, line 10, and page 21, line 6 discloses storing a unique identification for the message for the purposes of identifying a return receipt notification by transmitting the unique identifier to the recipient's MTA and matching the unique identifier upon the server receiving a receipt notification. Amended claim 9 does not claim storing a unique identification for the message for the purposes of identifying a return receipt. Amended claim 9 claims "the sender is provided with a unique identifier." Tomkow makes no such disclosure.

The Tomkow reference does not teach or even suggest a method where the server stores the unique identification of the message and the sender including an address of the sender in a database. This is not what is disclosed by Tomkow at page 16, lines 1-15, page 20, line 10, and page 21, line 6. The Tomkow reference only discloses storing a unique identifier for a message to a recipient. Storing the unique identification of the message and the sender including an address of the sender in a database is not storing a unique identifier for a message to a recipient. The Tomkow reference further discloses that the determination of the sender's address occurs by examining the original message. (Tomkow, page 34, lines 28-29; page 41, lines 8-12, 18; page 14, lines 26-28; page 18, lines 1-12; page 16, lines 16-21, 32; page 17, lines 1-3.) The Tomkow reference's determination of the sender's address by examining the original message is different from storing a unique identifier for the message and an address of the sender in a database, as is claimed by claim 9.

The Tomkow reference also does not teach or even suggest a method where the server determines the identification and address of the sender through the identification of the message stored in the database, locating in the database the identification of the message and the sender. This is not what is disclosed by Tomkow at page 10, line 5, page 11, line 14, page 31, line 24, and page 32, line 6. Tomkow only discloses storing a unique identification for the purposes of identifying a return receipt notification by transmitting the unique identifier to the recipient's MTA and matching the unique identifier upon the server receiving a receipt notification. Amended claim 9 does not claim storing a unique identification for the purposes of identifying a return receipt.

Moreover, the Tomkow reference discloses that the determination of the sender's address occurs by examining the original message. (Tomkow, page 34, lines 28-29; page 41, lines 8-12, 18; page 14, lines 26-28; page 18, lines 1-12; page 16, lines 16-21, 32; page 17, lines 1-3.)

Amended claim 9 does not claim that determination of the sender's address occurs by examining the original message. Rather, amended claim 9 recites that "the server determines the identification and address of the sender through the unique identification of the message." Determination of the sender's address by examining the original message is not the same as determination of the identification and address of the sender through the unique identification of the message, as is claimed in amended claim 9.

Further, Tomkow neither teaches nor suggests transmitting to the sender through the server any reply by the recipient to the sender. This is not what is disclosed by Tomkow at page 10, lines 11-15. Tomkow at page 10, lines 11-15, discloses storing destination information for the original message. For these reasons, Applicant respectfully submits that claim 9 as amended, and thus all of the claims dependent therefrom, is neither anticipated by, nor obvious in view of the cited art. Accordingly, Applicant requests that the rejections be withdrawn and that the claims be allowed.

Claim 11 has been amended to recite "transmitting the reply through the server to the true address of the sender, the reply not originating on the server." Tomkow neither teaches nor suggests transmitting the reply through the server to the true address of the sender, the reply not originating on the server. This is not what is disclosed by Tomkow at page 10, lines 11-15. Tomkow at page 10, lines 11-15, discloses storing destination information for the original message. The Tomkow reference does not use this information for a return transmission of a reply from the recipient to the sender.

Additionally, although Tomkow teaches a read receipt which is passed through the server by changing header information. (Tomkow, page 25, lines 25-33; page 15, lines 1-13.) , claim 11 not claim a read receipt which is passed through the server by changing the header information. Applicant's claim 11 provides for transmission of a reply, not a read receipt, to the sender through the server, the reply not originating on the server. A read receipt is an email sent to the author of a message by the recipient's Mail User Agent (MUA) when certain events occur (Tomkow, page 13, lines 20-21) and is consequently system generated. A reply is a new message initiated by the manual actions of a recipient and sent to the original sender by the recipient. Furthermore, a read receipt, unlike a registered reply, does not provide for proof of transmission or content of a reply generated by the recipient. A read receipt provides only proof

of transmission or content of the original message. (Tomkow, page 25, lines 22-30.) Therefore, a read receipt cannot be a reply.

Moreover, the Tomkow reference, page 12, lines 21-24, teaches "links that invite and allow the recipient to send a reply made of record to the message by linking to a Web Page from which messages made of record may be composed and sent." Claim 11 does not claim linking to a Web Page from which messages made of record may be composed and sent. Rather, claim 11 recites "return transmission of a reply from the recipient to the sender through the server, the reply not originating on the server." Hence, the claimed reply message originates from the recipient's mail client, and does not originate on the server. In contrast, Tomkow's reply originates from a Web Page from which messages made of record may be composed and sent, and therefore originates on a server displaced from the recipient. A Web Page from which messages made of record may be composed and sent is not a recipient's default mail client.

Accordingly, Applicant respectfully submits that claim 11 is novel and not obvious in view of the cited reference, and thus requests that the rejection be withdrawn and that claim 11, and the claims dependent therefrom, be allowed.

Claim 14 was rejected under 35 U.S.C. § 102(b), as being anticipated by Tomkow. The Applicant respectfully traverses the rejections in light of the arguments presented below.

Claim 14 has been amended to recite the step of "receiving a reply from the recipient to the server with the unique identification of the message." The Tomkow reference does not teach or suggest receiving a reply from the recipient to the server with the unique identification of the message. In contrast, Tomkow at page 10, lines 11-15, only discloses storing destination information for the original message. As claimed, the reply message of amended claim 14 originates from the recipient's mail client, and does not originate on the server. In contrast, the Tomkow reply originates from a Web Page from which messages made of record may be composed and sent, and therefore originates on a server displaced from the recipient. (Tomkow, page 12, 21-24.) A Web Page from which messages made of record may be composed and sent is not a recipient's default mail client.

Moreover, Tomkow neither teaches nor suggests storing the unique identification of the message and the sender address in an address in a database. Tomkow, at page 10, lines 11-15, and page 11, line 14, only discloses storing destination information for the original message.

Amended claim 14 does not claim storing destination information for the original message. Rather, amended claim 14 stores the sender's address in an address in a database. Destination information for the original message is not the same as storing "the sender address in an address in a database."

Further, Tomkow neither teaches nor suggests obtaining the address of the sender from the database on the basis of the unique identification of the message in the database. The Tomkow reference discloses storing a unique identifier for a message to a recipient (Tomkow, page 16, lines 1-15; page 20, line 10; page 21, line 6). Determining the identification and address of the sender through the identification of the message is not storing a unique identifier for a message to a recipient. The Tomkow reference discloses that the determination of the sender's address occurs by examining the original message. (Tomkow, page 34, lines 28-29; page 41, lines 8-12, 18; page 14, lines 26-28; page 18, lines 1-12; page 16, lines 16-21, 32; page 17, lines 1-3.) Amended claim 14 does not claim that determination of the sender's address occurs by examining the original message. Rather, amended claim 14 recites "obtaining the address of the sender from the database on the basis of the unique identification of the message in the database." Determination of the sender's address by examining the original message is not the same as obtaining (or determination of) the address of the sender from the database on the basis of the unique identification of the message in the database.

Accordingly, Applicant respectfully submits that claim 14 as amended is novel and not obvious in view of the cited reference, and thus requests that the rejection be withdrawn and claim 14, and its dependent claims, be allowed.

CONCLUSION

Applicant has carefully reviewed the arguments presented in the Office Action and respectfully requests reconsideration of the claims in view of the remarks presented. In light of the above amendments and remarks, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Should the Examiner have any questions concerning the above amendments and arguments, or any suggestions for further amending the claims to obtain allowance, Applicant requests that the Examiner contact Applicant's attorney, John Fitzgerald, at 310-242-2667.

The Commissioner is authorized to credit any overpayment or charge any additional fees in this matter to our Deposit Account No. 06-2425.

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Respectfully submitted,

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